

REMARKS

Amendments

Claims 1-10 are amended to use claim language in accordance with conventional US practice, delete superfluous language, and/or correct claim dependency. Additionally, claim 9 is amended to be a method claim. These amendments are not intended to narrow the scope of the claims.

New claims 11-20 are directed to further aspects of applicants' invention. Support for these amendments can be found throughout the disclosure. See, e.g., the original claims, page 5, line 35-page 6, line 33, page 8, line 19-page 9, line 16, page 10, lines 20-21, page 10, lines 27-29, and page 11, line 31-page 12, line 2.

Election

In response to the Restriction Requirement, applicants' hereby elect Group I, claims 1-7, drawn to a process. In addition, with respect to the Election of Species Requirement, applicants hereby elect the species wherein: (a) the epoxy compound of formula I is diglycidyl ether of 4,4'-dihydroxy-3,3',5,5'-tetramethyl biphenyl (see examples 3-6), and (b) the reaction is conducted without a tertiary alcohol being present. With respect to the epoxy compound of the elected species, this compound is encompassed by formula IV in which Y is a direct bond. However, Restriction/Election of Species is respectfully traversed.

In the Restriction, it is argued that, under PCT Rule 13.2, the subject matter of Groups I and II "lack the same or corresponding special technical feature." In this regard, it is argued that the "special technical feature" which is lacking is the performing of a reaction at a temperature from about 95°C to about 150°C of an epoxy compound of formula (I) in the presence of an alkali metal hydroxide.

Firstly, applicants note that claim 1 recites reacting an epoxy compound according to formula (I) in the presence of alkali metal hydroxide at temperature of 95°C - 150°C. Applicants further note that claim 8 is directly dependent on claim 1, and thus includes the same feature. Thus, contrary to the allegation in the Restriction, the subject matter of Group I and the subject matter Group II have the feature which the Examiner has seemingly arbitrarily designated as the "special technical feature."

Secondly, the Restriction does not provide any rationale as to why the feature selected by the Examiner is deemed to be the “special technical feature” pursuant to PCT Rule 13.2. For example, claim 1 (and, through its dependency, claim 8) recites that the epoxy compound of formula I, which is reacted in the presence of alkali metal hydroxide at temperature of 95°C - 150°C, in which the proportion of the component having an “n” equal to 0 is more than 70% and less than 100%. The Restriction does not explain why this feature is not considered the “special technical feature.”

Finally, the Examiner argues that the “special technical feature” selected for the basis of the Restriction does not make a contribution over the prior art and, as a result, there is lack of unity of invention. This argument is based on the disclosure of Darbellay et al. (US 4,668,807). However, the argument fails to demonstrate how US ‘807 discloses or suggests reacting a compound of applicants’ formula I in the presence of alkali metal hydroxide at temperature of 95°C - 150°C, in which the proportion of the component having an “n” equal to 0 is more than 70% and less than 100%.

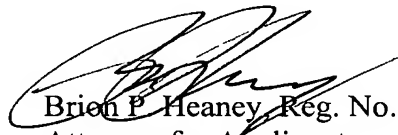
It is noted that, pursuant to PCT Rule 13.2, certain combinations of claims will be held to possess the “special technical feature” mentioned in PCT Rule 13.2 and thus exhibit unit of invention. See, for example, MPEP §1850 (III), page 1800-98, wherein it is stated that a process shall be considered specially adapted for the manufacture of a product if the claimed process inherently results in the claimed product, regardless of whether the product can be made by another process.

As for the Election of Species, the Office Action fails to indicate how the election of species requirement as to species b) and c) (set forth at page 3 of the Office Action) is justified under PCT Rule 13. As for species a), the Office Action fails to establish that an election of species is justified under the “Markush Practice” under PCT Rule 13.2. See MPEP §1850 (III)(B).

In view of the above remarks, withdrawal of the Restriction and Election of Species Requirements, and examination of all pending claims together in the instant application is respectfully requested.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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